

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

(Attorney Reference No.: SIR-MIS-00001-US-CIP[2])

IN THE APPLICATION OF:)		
)		
McSwiggen <i>et al.</i>)		
)		
Serial No.	10/693,059) Examiner:	Pitrak
)	
Filed:	October 23, 2003) Group Art Unit:	1635
)	
Title	RNA Interference Mediated) Confirmation No.:	1557
	Inhibition of Gene Expression)	
	Using Chemically Modified)	
	Short Interfering Nucleic Acid)	
	(siNA))	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE COMMUNICATION MAILED OCTOBER 27, 2009

Sir:

Applicants now respond to the Notice of Non-Compliant Appeal Brief mailed on October 27, 2009. No fees are thought to be presently due; however, the Commissioner is authorized to charge payment of any additional fees required in connection with the paper(s) transmitted herewith, or to credit any overpayment of the same, to Deposit Account No. 50-4615.

Remarks begin on page 2 of this paper.

REMARKS

The Office in its communication, mailed October 27, 2009, noted that the Appeal Brief filed on October 2, 2009 was defective for failure to contain a statement of the status of all claims canceled.

First, Applicants want to thank Bridget C. Monroe for providing clarification. Applicants have amended page 4 of the Appeal Brief, which contains the Status of the Claims section, to include a statement that "Claims 1-17 and 19 are canceled." Applicants have attached hereto, as a Replacement Sheet, page 4 of the Appeal Brief with the above stated amendment and request entry of this page into the Appeal Brief.

Applicants believe that in view of the amendment that the Appeal Brief is now in compliance.

Respectfully submitted,
Merck & Co., Inc.

Date: November 19, 2009

/Elaine C. Stracker/
Elaine C. Stracker
Registration No. 43,166

1700 Owens Street, 4th Floor
San Francisco, CA 94158
Phone: 415-814-8468
Email: elaine_stracker@merck.com

REPLACEMENT SHEET

REAL PARTY IN INTEREST

The real party in interest is Sirna Therapeutics, Inc., which is a wholly owned subsidiary of Merck & Co. Inc.

RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are pending.

STATUS OF CLAIMS

Claims 18 and 20-33 are pending and stand rejected. Claim 18 has been amended. A copy of the claims on appeal is attached in Appendix A. A copy of the amended claim is attached in Appendix D. Claims 1-17 and 19 are canceled.

STATUS OF AMENDMENTS

A Final Office Action was mailed on February 3, 2009. A first response to Final Office Action was filed on May 28, 2009, wherein claim 18 was amended to more exactly state the first strand as the sense strand and the second strand as the antisense strand. An Advisory Action was mailed on June 15, 2009. Claim 18 has been amended in part c) to recite "the sense strand, antisense strand, or both strands comprise five or more nucleotides each having a Northern conformation modification;" No other amendments have been made.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The invention provides certain chemically modified double stranded nucleic acid molecules, each comprising a sense strand and a separate antisense strand of 19 to 29 nucleotides in length, wherein the sense strand, the antisense strand, or both the sense and the antisense strands comprises five or more nucleotides that are each modified by a Northern conformation modification, and at least two of the Northern modifications are different from each other. *See* claim 18; Specification at, *inter alia*, page 8, lines 24-27; page 11, lines 22-24; page 40, line 22, to page 41, line 27; page 41, line 28, to page 42, line 2; Figures 18, 19; Tables I & IV.

Each of the molecules above can comprise one or more ribonucleotides, and thus are not fully or completely chemically modified. *See* claim 20; Specification at, *inter*